

Amendment under 37 C.F.R. §1.116
Serial No. 10/084,327
Attorney Docket No. 000738A

REMARKS

Claims 9, 13-16 and 18-22 are pending in the application, and are rejected. Claim 9 is herein amended, incorporating the limitations from claim 16. Claim 16 is herein canceled.

Claim rejections under 35 U.S.C. §103(a)

Claims 9, 13-15 and 19-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,618,648 to Horikoshi et al. in view of U.S. Patent No. 6,194,115 to Nagase et al., and further in view of JP 5-107805 and the admitted prior art. Claim 16 is rejected as claims 9, 13-15, 19, 20 and 21 above, and still further in view of Inaba et al. in U.S. Patent No. 5,741,617. Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable as claims 9, 13-15, 19, 20 and 21 above, and still further in view of *Handbook of Imaging Materials to Diamond*, pp. 201-202.

Applicants herein amend claim 9 by importing the limitations from claim 16, which is subsequently canceled. Thereafter, Applicants respectfully disagree with the above rejection, because not all of the claimed limitations are suggested by the cited combination of references.

Applicants note that claim 16 is supported by Examples in the specification, namely, Toner 3 on Table 2 (page 34) and Toners 10, 11, 13 and 14 on Table 4 (page 38). The Examiner asserted in the previous Office Action dated July 9, 2003 that U.S. Patent No. 5,741,617 to Inaba discloses a wax composition containing ester waxes such as Ester Compound No. 4 (column 8), and the Examiner concluded that it would have been obvious to one skilled in the art to use the exemplified ester wax of Inaba in the invention of U.S. Patent No. 5,618,648 to Horikoshi.

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However, Applicants note that the Ester Compound No. 4 of Inaba does not meet the chemical formula of Claim 16.

Moreover, Example 1 of Inaba shows that a wax is contained in a toner in an amount of 60 parts by weight based on 286 total parts of components, and the wax has 74 wt% of the ester wax component. Thus, the content of the ester wax can be calculated by the following equation:

$$(60) / (286) \times (100) \times (0.74) = 15.5 \text{ wt\%}.$$

Applicants note that 15.5 wt% is more than 50% higher than the top of the range required by claim 9 as presently amended, which recites a range of 0.01 to 10 parts for 100 parts by weight of the toner of the wax component. Therefore, even if Inaba were properly combined with Horikoshi and the other cited references, Applicants submit that not all of the claimed limitations would be taught or suggested.


In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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